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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,586	02/04/2005	Goro Katsuyama	265146US3PCT	5815
22850	7590	05/03/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER, & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER POLLICOFF, STEVEN B	
			ART UNIT 3728	PAPER NUMBER
			NOTIFICATION DATE 05/03/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/523,586

Applicant(s)

KATSUYAMA, GORO

Examiner

Steven B. Pollicoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/4/05, 7/15/05, 12/4/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-32,44-47,51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Resta (EP 0284703 A1).

With respect to claim 28, Resta discloses a packing member capable of packing an ink cartridge that has a coat of adhesive on one surface, comprising: a first portion (Resta Fig 4 ref 6); a second portion (ref 11,12); and a cutting portion (at ref 3) between the first portion and the second portion, wherein the first portion and the second portion can be readily torn apart at the cutting portion, wherein the ink cartridge is capable of being packed by adhering a surface of the packing member on the ink cartridge and unpacked by tearing off the first portion by pulling the first portion in a specific direction (column 4, lines 11-17).

With respect to claims 29 and 30, Resta discloses a release coated paper (Fig 4 ref 2) that is adhered on the surface of the packing member, wherein when packing the ink cartridge, the release coated paper is partially peeled (see underneath flap ref 7) from the first portion so that the surface of the packing member can be stuck to the ink cartridge.

With respect to claim 31, Resta discloses that the release coated paper includes a plurality of portions that are separated by cutting lines (ref 3) that overlap with the cutting portion.

With respect to claim 32, Resta discloses that adhesive is partially exposed on a surface of the first portion (Fig 4 ref 10).

With respect to claim 44, Resta is capable of having the label/packing member first portion seal an ink supplying portion of an ink cartridge.

With respect to claim 45, Resta is capable of having the second portion adhered on a joint of an exterior case of an ink cartridge after unpacking the ink cartridge since Resta discloses that a portion of the label is permanently stuck to the package (column 2, lines 7-9).

With respect to claim 46, Resta is capable of having the second portion adhered on a separate part that is set in the ink cartridge to cover an ink supplying portion after unpacking the ink cartridge, in as much as applicant has claimed an ink cartridge.

With respect to claim 47, Resta discloses that the packing member is constituted as a sheet of adhesive label (see Abstract).

With respect to claims 51 and 52, Resta discloses information indicated on the first and second portions (column 3, lines 28-36).

Claims 28 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Nanjo (US Pat 6942325).

With respect to claims 28 and 53, Nanjo discloses a combination of an ink cartridge and a packing member for packing the ink cartridge, wherein the packing

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member includes a first portion (Nanjo Fig 1A ref 103b); a second portion (103a); and a cutting portion (115) between the first portion and the second portion, wherein the first portion and the second portion can be readily torn apart at the cutting portion (Fig 5B and 5C); wherein the ink cartridge is packed by adhering a surface of the packing member on the ink cartridge (at 120; see also column 6, lines 56-57) and unpacked by tearing off the first portion by pulling the first portion in a specific direction (Fig 5B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Resta (EP 0284703 A1) in view of Good (US Pat 5728440).

With respect to claim 33, Resta does not disclose hanging portion that has a hole for hanging from a rail. However, Good discloses a label directly adhered to a product having a hanging portion that has a hole for hanging from a rail. Therefore, it would

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have been obvious to one having ordinary skill in the art at the time the invention was made to modify the label of Resta to include a hanging portion that has a hole for hanging from a rail, as taught by Good, for the purpose of displaying the adhered product on a single wire hanger in a retail store.

With respect to claim 34, Resta discloses a release coated paper (Fig 4 ref 2) that is adhered (at ref 10) on the surface of the packing member, wherein when packing the ink cartridge the release coated paper is partially peeled so that a portion of which is partially left in the hanging portion (see flap ref 7).

With respect to claim 35, Resta as modified discloses that the hanging portion is formed by the release coated paper that is partially left in the hanging portion and is sandwiched by two sheets (i.e. Resta Fig 4 the second portion ref 11,12).

With respect to claim 36, Resta as modified discloses an end side of the release coated paper that is partially left in the hanging portion serves as an assisting line to form the hanging portion (Resta Fig 4 at ref 7, the side end of the flap).

With respect to claim 37, Resta as modified discloses that the release coated paper that is partially left in the hanging portion has an identical shape (i.e. rectangular) as the two sheets (compare Fig 4 ref 11,12 and 7).

With respect to claim 38, it appears applicant has written a product by process claim. A product by process limitation adds no patentable distinction to the claim and is unpatentable if the claimed product is the same as a product of the prior art. Here, the prior art discloses a packing member having a hanging portion and the claim does not further limit the prior art by stating that the packing member is "unpacked" from the

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hanging portion. Therefore, claim 38 stands rejected as being obvious over Resta in view of Good.

With respect to claim 39, Resta disclose that the just below the hanging portion adhesive is exposed widely (Fig 4 at ref 10 surrounding the periphery of the removable flap/hanging portion).

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Resta (EP 0284703 A1) in view of Good (US Pat 5728440) as applied to claims 28 and 33 above and further in view of Rich et al., (US Pat 5944355).

With respect to claim 40, Resta as modified does not disclose that the cutting portion and an end side of the hanging portion are on an identical line. However Rich does disclose a cutting portion and end side of a hanging portion on an identical line (Fig 1 at ref 106). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Resta such that the cutting portion and an end side of the hanging portion are on an identical line, for the purpose of creating a more clean perforation initiation position when detaching the hanging portion from the remainder of the label and product (Rich column, 8 lines 49-50).

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Resta (EP 0284703 A1) in view of Good (US Pat 5728440) as applied to claims 28 and 33 above and further in view of Nanjo (US Pat 6942325).

With respect to claims 41 and 42, Resta as modified does not disclose cuttings that are arranged on extension lines of both end sides of the hanging portion. However, Nanjo discloses cuttings (Nanjo Fig 5A see cuts at the sides of holding portion ref 112)

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that are arranged on extension lines of both end sides of a cover member/hanging portion (at ref 103b) and linked to cutting portions (at ref 115). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Resta to include cuttings, as taught by Nanjo, for the purpose of more easily recognizing the cover member/hanging portion and more easily detaching the cover member/hanging portion from the rest of the packaging (column 8, lines 2-14).

Claims 43 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Resta (EP 0284703 A1).

With respect to claim 43, Resta discloses a release coated paper (Fig 4 ref 2) that is adhered on the surface of the packing member, but does not disclose that wherein when packing the ink cartridge, the release coated paper is partially peeled across the cutting portion along a cutting line so that the surface of the packing member can be stuck to the ink cartridge. However, it would have been an obvious matter of design choice to have a portion of the release coated paper partially peeled across the cutting portion along a cutting line so that the surface of the packing member may be stuck to the ink cartridge/product, since applicant has not disclosed that by doing so solves any stated problem or is for any particular purpose and it appears that the invention would perform equally as well with flap portion of the label in Resta. The flap portion allows the rest of the label/packing member to adhere/be stuck to the product.

With respect to claim 48, it appears applicant has written a product by process claim. A product by process limitation adds no patentable distinction to the claim and is unpatentable if the claimed product is the same as a product of the prior art. Here, the

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prior art discloses a packing member and the claim does not further limit the prior art by stating that the packing member is "formed by punching". Therefore, claim 48 stands rejected as being obvious over Resta.

With respect to claim 49, Resta discloses a release coated paper (Fig 4 ref 2) that includes a plurality of portions (i.e. between perforations) that are separated by cutting lines (Fig 4 at ref 3). With respect to the cutting lines being "formed by die cutting," it appears applicant has written a product by process claim. A product by process limitation adds no patentable distinction to the claim and is unpatentable if the claimed product is the same as a product of the prior art. Here, the prior art discloses a packing member having a release coated paper including a plurality of portions separated by cutting lines and the claim does not further limit the prior art by stating that the packing member is "formed by die cutting". Therefore, claim 49 stands rejected as being obvious over Resta.

With respect to claim 50, it would have been an obvious matter of design choice to have the first portion shaped in a Y-shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey 149 USPQ 47.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo (US Pat 6942325).

With respect to claim 54, Nanjo discloses a method for packing an ink cartridge with a packing member that has a coat of adhesive on one surface, and unpacking the

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ink cartridge that is packed with the packing member, comprising: adhering the one surface of the packing member (Fig 5B ref 120) on the ink cartridge to pack the ink cartridge; and tearing off a portion of the packing member by pulling the portion in a specific direction to unpack the ink cartridge (Fig 5B).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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